

12/16/96


Patent and Trademark Office

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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/620,482

03/22/96

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THOMAS G. KENRY
 WOODARD EMHARDT NAUGHTON MARIARTY &
 MCNETT
 111 MONUMENT CIRCLE SUITE 3700
 INDIANAPOLIS IN 46204

A3N1/1216

EXAMINER

CINTINS, I

ART UNIT

PAPER NUMBER

1308

21

DATE MAILED:

12/16/96

This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY
☐ Responsive to communication(s) filed on _____

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims
☒ Claim(s) 1, 3-6, 8-17, 20-22 + 24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-6, 8-17, 20-22 + 24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers
☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119
☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)
☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1308

Claims 8 and 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. The claims depend from a canceled claim (i.e. claim 7), and are therefore indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 9-13 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by Teng et al. (U.S. Patent No. 3,788,984, hereinafter "Teng '984"). Applicants should note that Teng '984 subjects a lignocellulosic material such as sawdust (col. 3, line 35) or paper (col. 3, lines 39-40) to esterification with acetic anhydride (col. 2, line 61); and since this procedure appears to be identical to that used by Applicants to produce their product (see page 3, lines 11 and 29 of the specification), the reference material is deemed to be patentably indistinguishable from the material recited in the claims of this application.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 3, 4, 8, 15, 17 and 22 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '984. The reference discloses the claimed invention with the exception of the weight gain of the treated material (claims 3 and 4), the type of lignocellulosic material employed (claim 8), the type of oil removed (claims 15 and 17), and the physical form (i.e. sheet) of this material (claim 22). However, the exact weight gain of the reference material after treatment, its type and physical form, and the exact type of oil removed are not seen to materially affect the overall results of the recited process or product, or to produce any new and unexpected result; and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 14, 20, 21 and 24 are rejected under 35 U.S.C. § 103 as being unpatentable over Teng '984 in view of Fahlvik. The

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primary reference discloses the claimed invention with the exception of the outer covering for the modified plant material. Fahlvik discloses encasing a cellulosic oil absorbent material in a mesh covering. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified plant material of the primary reference with the covering of the secondary reference, in order to facilitate handling of this primary reference material.

This is a continuation of Applicants' earlier application S.N. 08/050,060. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on (703) 308-3837. The fax phone number for this Group is (703) 305-3602.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1308

I. Cintins
December 12, 1996